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FROM: Mitchell K. McCarthy, Registration No. 38,794

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Art Group 2816	571/273-8300	571/272-4100

RE: **Application No. 10/625,386**
In re application of: Sundeep Chauhan
Assignee: SEAGATE TECHNOLOGY LLC
Dkt. No.: STL10986

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): STL10986

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on 6-28-06

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Typed or printed name Mitchell K. McCarthy

Application Number	Filed
10/625,386	July 23, 2003

First Named Inventor: Sundeep Chauhan

Art Unit	Examiner
2816	Hai L. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____
- [X] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 38,794

[signature]
Signature

Mitchell K. McCarthy
Typed or printed name

(405) 232-0621
Telephone number

6/28/2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 forms are submitted.

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PATENT
Dkt. STL10986

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Sundeep Chauhan**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **10/625,386** Art Unit: **2816**
Filed: **July 23, 2003** Examiner: **Hai L. Nguyen**
For: **HIGH SPEED DIGITAL PHASE/FREQUENCY COMPARATOR FOR PHASE LOCKED LOOPS**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant is entitled to a patent unless the invention was patented or described.... 35 USC 102(b). Any rejection shall state the reasons for them, together with information as may be useful in judging the propriety of continuing prosecution of the application. 35 USC 132. In this case Applicant has repeatedly argued that the Examiner's rejections are based only upon misstatements of the law, mischaracterizations of the specification, and mischaracterizations of the cited reference. The Examiner reticently stood by these bases in the Advisory Action. Applicant now prays that the Panel's objective review will conclude that all the unresolved issues clearly raised by Applicant during prosecution are not bona fide matters for appeal, but rather are issues that must be resolved before this case is in condition for appeal.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a)

I hereby certify that, on the date shown below, this correspondence is being:
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Date: June 28, 2006

Mitchell K. McCarthy
(type or print name of person certifying)

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A *PRIMA FACIE* CASE OF ANTICIPATION BECAUSE THE CITED REFERENCE FAILS TO DISCLOSE ALL THE FEATURES RECITED BY INDEPENDENT CLAIMS 1 AND 20

Applicant repeatedly reiterated that Staszewski '693 does not identically disclose a *transition location signal* as in claim 1 or a *transition location of the first signal* as in claim 20. **(see Applicant's Response filed 5/30/2006 ppg. 9-14 and 17-18; Applicant's Response filed 11/28/2005 ppg. 13-18 and 20-22)**

Following is a summary of the arguments raised by Applicant during prosecution as to why the Examiner's rejection is clearly reversible error and thus not sustaining of a prima facie case of anticipation:

1. The Examiner maintained the rejection, without supporting legal authority, by stating that in order to construe a claim term in accordance with its ordinary meaning consistent with its usage in the specification requires an explicit definition of the term in the specification. This is an arbitrary misstatement of the law, leaving an unresolved legal issue that must be resolved before this case is in condition for appeal. **(see Applicant's Response filed 5/30/2006 ppg. 9-10)**

2. The Examiner argued that the claim term *transition location signal* is not explicitly defined in the specification. However, the specification states in part:

> N-bit edge detect circuit 304 outputs a single bit at the transition point of a falling edge (or rising edge, depending on the design) in the snapshot provided by N-bit parallel latch 302. This signal bit may be referred to as a transition location signal.

The Examiner refused to recognize this as an explicit definition by stating it "is considered a permissible term rather than a clear definition." The Examiner provided no reasoned statement as to why a skilled artisan reading the specification would be unclear as to what the *transition location signal* is. The Examiner provided no legal basis for the distinction between permissible terms and clear definition. This is an arbitrary distinction, leaving an unresolved factual issue and an unresolved legal issue that must be resolved before this case is in condition for appeal. **(see Applicant's Response filed 5/30/2006, ppg. 10-11)**

3. The Examiner pushed "broadest reasonable interpretation consistent with the specification" beyond reasonableness to absurdity by reading the time-to-digital circuit of the cited reference onto the claimed *transition location signal*. Applicant has repeatedly argued that the skilled artisan readily recognizes the difference between a timing signal and a location

signal. The Examiner did not respond, but rather staked out an arbitrary position without a reasoned explanation or an evidentiary basis for it, leaving an unresolved factual issue that must be resolved before this case is in condition for appeal. **(see Applicant's Response of 5/30/2006, ppg. 11-12)**

4. In maintaining the rejection the Examiner stated: "TDC_RISE, TDC_FALL...directly indicates the location of the feedback clock 114 through the tapped delay line 502's precisely at the occurrence of the feedback transition signal 110." However, Applicant argued that the cited reference is wholly silent in support of the Examiner's statement. The Examiner did not reply but rather has finally rejected the claims based on an arbitrary mischaracterization of the reference, leaving an unresolved factual issue that must be resolved before this case is in condition for appeal. **(see Applicant's Response of 5/30/2006, pg. 12)**

5. In maintaining the rejection the Examiner stated: "nothing in the specification indicates that the N-bit tapped delay line 300 initializes at the beginning of each clock reference 301 cycle." However, Applicant argued that the skilled artisan would recognize that the Examiner's statement is erroneous from a plain reading of the specification, which states:

> For example, if N=5, and a transition from low to high (0 to 1) is made, delay line 300 will first output 00000, then 10000, then 11000, then 11100, then 11110, then finally 11111, at which the outputs of delay line 300 will remain until another transition input signal 301 is made.

The Examiner did not reply but rather finally rejected the claims based on an arbitrary mischaracterization of the specification, leaving an unresolved factual issue that must be resolved before this case is in condition for appeal. **(see Applicant's Response of 5/30/2006, ppg.12-13)**

Upon review and consideration of these points, the Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. Applicant has argued that Staszewski '693 fails in this regard, but the Examiner has only reticently maintained his position without any evidentiary basis whatsoever.

Applicant now prays for an objective review of the legal and factual deficiencies of this rejection, and agreement that it should be withdrawn. Only a travesty in equities would require Applicant to proceed to appeal on a rejection lacking a substantiated prima facie case and otherwise based on mischaracterizations of what the cited reference and specification disclose.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A *PRIMA FACIE* CASE OF ANTICIPATION BECAUSE THE CITED REFERENCE FAILS TO DISCLOSE ALL THE FEATURES RECITED BY INDEPENDENT CLAIM 10

Applicant repeatedly reiterated that Staszewski '693 does not identically disclose *encoding circuitry coupled to the phase detecting stage* as claimed. **(see Applicant's Response filed 5/30/2006 ppg. 14-17; Applicant's Response filed 11/28/2005 ppg. 18-20)**

Following is a summary of the arguments raised by Applicant during prosecution as to why the Examiner's rejection is clearly reversible error and thus not sustaining of a prima facie case of anticipation:

1. The Examiner maintained the rejection, without citing legal support, by stating that in order to construe a claim term in accordance with its ordinary meaning consistent with its usage in the specification requires an explicit definition of the term in the specification. This is an arbitrary misstatement of the law, leaving an unresolved legal issue that must be resolved before this case is in condition for appeal. **(see Applicant's Response filed 5/30/2006 ppg. 14-15)**

2. The Examiner argued that the claim term *encoding circuitry* is not explicitly defined in the specification. However, Applicant argued that the disclosed weighted encoder 306, which "converts the output of N-bit edge-detect circuit 304 into a numerical phase difference value...." (specification pg. 7 lines 11-13) clearly defines the disputed claim term. The Examiner did not respond but rather maintained the arbitrary position, leaving an unresolved factual issue that must be resolved before this case is in condition for appeal. **(see Applicant's Response filed 5/30/2006, ppg. 15)**

3. The Examiner pushed "broadest reasonable interpretation consistent with the specification" beyond reasonableness to absurdity by reading the normalization circuit of Staszewski '693 onto the claimed *encoding circuitry*. Applicant repeatedly argued that the skilled artisan readily recognizes the functional differences between normalizing and encoding. The Examiner did not respond, but rather staked out an arbitrary position with no reasoned statement or evidentiary basis for it, leaving an unresolved factual issue that must be resolved

before this case is in condition for appeal. (see **Applicant's Response of 5/30/2006, ppg. 15-16**)

4. The Examiner maintained the rejection based on the statement: "The circuit (NORM) of Fig. 2 of Staszewski is an encoding circuitry since it converts the input digital signal into its equivalent binary code...." (Office Action of 11/28/2005, pg. 8) However, Applicant pointed out that the cited reference is wholly silent in support of the Examiner's characterization of it. The Examiner did not reply but rather has finally rejected the claims based on an arbitrary mischaracterization of the reference, leaving an unresolved factual issue that must be resolved before this case is in condition for appeal. (see **Applicant's Response of 5/30/2006, pg. 16**)

Upon review and consideration of these points, the Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. Applicant has argued that Staszewski '693 fails in this regard, but the Examiner has only reticently maintained his position without any evidentiary basis whatsoever.

Applicant now prays for an objective review of the legal and factual deficiencies of this rejection, and agreement that it should be withdrawn. Only a travesty in equities would require Applicant to proceed to appeal on a rejection lacking a substantiated prima facie case and otherwise based on mischaracterizations of what the cited reference and specification disclose.

Respectfully submitted,

By: _____

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